

REMARKS

This Supplemental Response After Final Rejection is submitted in response to the outstanding Advisory Action, dated May 12, 2009. The present application was filed on February 26, 2004 with claims 1 through 20. Claims 1-3, 6-9, 12-16, 19, and 20 were cancelled in previous responses. Claims 4, 5, 10, 11, 17, and 18 are presently pending. A Request for Continued Examination is being submitted herewith.

In the Office Action, the Examiner rejected claims 4-5, 10-11 and 17-18 under 35 U.S.C. §102(e) as being anticipated by Chen et al. (United States Publication No. 2005/0160223).

Independent Claims 5, 11 and 18

Independent claims 5, 11, and 18 were rejected under 35 U.S.C. §102(e) as being anticipated by Chen et al. In the Response to Arguments section of the final Office Action, the Examiner asserted that the declaration filed under 37 CFR 1.131 is ineffective to overcome the Chen reference. In particular, the Examiner asserted that the evidence submitted is insufficient to establish diligence from the date of submission of the Invention Summary form (July 11, 2003) to the date on which Mr. Mason and Mr. Devine met (January 12, 2004), from January 12, 2004 to February 3, 2004, and from February 5, 2004, to February 23, 2004. In the Advisory Action, the Examiner asserts that there are gaps in Applicant's diligence from conception on May 13, 2003 to submission to Agere IP on July 11, 2003 and from October 15, 2003 until the meeting on January 12, 2004.

Applicants traverse the §102(e) rejection of claims 4-5, 10-11 and 17-18 for at least the following reasons. Applicants concurrently file herewith a revised Declaration of Prior Invention Under 37 C.F.R. §1.131 and a Declaration from Mr. Kevin M. Mason, an attorney of record. While Applicants maintain that the original Declaration establishes conception of the invention prior to the effective date of Chen et al., coupled with due diligence from prior to such effective date until the filing date of the present application, Applicants submit the revised and new Declarations to address the concerns raised by the Examiner. The attached Declarations establish conception of the invention prior to the effective date of Chen et al., coupled with due diligence from prior to such effective date until the filing date of the present application.

As indicated in the Declaration of Prior Invention Under 37 C.F.R. §1.131, the invention was conceived as early as May 13, 2003 as evidenced by the internal Agere System Requirements Document entitled "USS2827 USB 2.0 Device Controller." A copy of the Requirements Document is attached hereto as Exhibit 2. See also, a draft of a presentation
5 entitled "Wired Product Line USB/1394 Product Family," wherein sheet 16 of the presentation shows a product roadmap including the USS2827 - USB 2.0 Device Controller which is a USB 2.0 device controller incorporating the ARM processor described in the above-identified application. A copy of the presentation attached hereto as Exhibit 1. The creation date of the presentation is May 2, 2003, as evidenced by the screenshot attached hereto as Exhibit 1A.

10 During the period of May 13, 2003, to July 11, 2003, the inventors diligently worked on the invention of the above-identified patent application and exchanged a continuous stream of electronic mail messages with colleagues regarding the invention, as evidenced by a transcript of the electronic mail messages. A copy of the electronic mail transcript is attached hereto as Exhibit 3.

15 On May 27, 2003, Mr. Prasad, an employee of Agere, sent a note via electronic mail to David Thompson and Sherre Staves with queries related to the "USS2827 USB 2.0 Device Controller." A copy of the electronic mail from Mr. Prasad is attached hereto as Exhibit 4.

20 During the months of June and July, 2003, we prepared an Invention Submission document as required by Agere. On or about July 11, 2003, the Invention Submission document, subsequently assigned Submission No. 124809, entitled "ARM7 Processor based USB 2.0 Device Controller," was submitted to a former Agere in-house patent attorney, Robert P. Marley. The date that the Invention Submission document was Received by Agere IP Law is noted in the upper right hand portion of the document as July 11, 2003. A copy of the Invention Submission
25 document dated July 11, 2003 is attached hereto as Exhibit 5.

In accordance with the standard practices of Agere Systems ("Agere"), the Invention Submission document was queued for review by the former in-house patent attorney, Robert P. Marley. Mr. Marley subsequently reviewed the Invention Submission and presented it for an internal review by the Agere Systems Patent Committee on or about August 13, 2003.

On or about September 10, 2003, the Agere Systems Patent Committee approved the assignment of the patent application to Ryan, Mason & Lewis, LLP ("RML").

The Requirements Document and the Invention Submission document describe an invention falling within one or more of the claims of the present application. For example, Applicants note that pending claims 4, 5, 10, 11, 17, and 18 are supported by FIG. 3 and the corresponding discussion of the present application (This figure appears on page 4 of the Requirements Document). Exhibits 2 and 5 provide evidence that the aspects of the invention claimed in claims 4, 5, 10, 11, 17, and 18 and supported by FIG. 3 were conceived on or before May 13, 2003.

On October 15, 2003, a letter was sent to Ryan, Mason & Lewis, LLP requesting that the patent application be prepared and filed. A copy of the letter dated October 15, 2003 is attached hereto as Exhibit 6. RML subsequently accepted the patent application request and, in standard practice with RML, assigned the application to Mr. Kevin Mason.

During the period of October 18-21, 2003, RML circulated among all RML attorneys and Patent Agents a "New Matters Conflict List" that included the above-identified patent application. A copy of the "New Matters Conflict List" is attached hereto as Exhibit A.

On October 20, 2003, Mr. Mason sent Mr. Devine a message via electronic mail introducing himself as the attorney handling preparation of the above-identified patent application. As indicated in the message, it was estimated that Mr. Mason would begin actively working on the application in late November, 2003, due to the caseload at that time. A copy of the electronic mail message is attached hereto as Exhibit B.

During the period from prior to October 20, 2003 until January 12, 2004, Mr. Mason was responsible for a large number of unrelated cases and it was his general practice to arrange initial evaluation meetings with inventors substantially in the order in which the computerized invention disclosure documents were received in the system.

During the period from prior to October 20, 2003 until January 12, 2004, Mr. Mason reviewed the Requirements Document and Invention Submission document and requested a meeting with Mr. Daniel Devine, a co-inventor of the above-referenced application.

On or about January 12, 2004, Mr. Kevin Mason and Mr. Daniel Devine met to discuss the above-referenced application. A copy of an electronic mail message from Mr. Devine to Mr. Mason documenting this meeting is attached hereto as Exhibit 7.

Mr. Mason studied the Invention Submission document and notes from the
5 meeting on or about January 12, 2004 and started preparation of the patent application.

On or about February 3, 2004, Mr. Devine provided electronic copies of the disclosure material via electronic mail to Mr. Mason. A copy of an electronic mail message from Mr. Devine to Mr. Mason documenting this exchange is attached hereto as Exhibit 8.

On or about February 5, 2004, a first draft of the present application was sent via
10 electronic mail by Mr. Mason to Mr. Devine. A copy of an electronic mail message from Mr. Mason to Mr. Devine documenting this exchange is included in the email history shown in Exhibit 9.

Mr. Devine reviewed the application and met with a co-inventor to receive additional comments.

On or about February 23, 2004, Mr. Devine approved the draft application. A
15 copy of an electronic mail message from Mr. Devine to Mr. Mason containing this approval is included in the email history shown in Exhibit 9.

A final draft was sent via electronic mail to Mr. Devine on February 23, 2004. A
copy of an electronic mail message from Mr. Mason to Mr. Devine documenting this exchange is
20 included in the email history shown in Exhibit 9.

The final draft was approved by Mr. Devine on February 23, 2004. A copy of an electronic mail message from Mr. Devine to Mr. Mason documenting this approval is included in the email history shown in Exhibit 9.

As noted above, the present patent application was filed by Mr. Mason on
25 February 26, 2004.

Applicants maintain that the cited exhibits demonstrate conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to the filing of the application.

Accordingly, Applicants assert that, since the filing date of Chen et al. is January
30 15, 2004, Chen et al. is not a proper prior art reference.

Applicants respectfully request the withdrawal of the rejection of pending claims 4, 5, 10, 11, 17, and 18.

All of the pending claims, i.e., claims 4, 5, 10, 11, 17, and 18, are in condition for allowance and such favorable action is earnestly solicited.

5 If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

Respectfully submitted,



10 Date: June 23, 2009

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